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EXAMINER

HOSSAIN, FARZANA E

ART UNIT PAPER NUMBER

2623

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/003,196	MASSEY, KENT	
	Examiner	Art Unit	
	Farzana E. Hossain	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-18 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4,6-18 and 20-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03-17-06 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08-31-06 has been entered.

### ***Response to Amendment***

2. This office action is in response to communications filed 08-31-06. Claims 1, 3, 4, 6-9, 18, 20, 22-24, 27, 30-34 are amended. Claims 2, 17, 21, 25, 26, 28, 29 are original. Claims 5 and 19 are cancelled.

### ***Response to Arguments***

3. Applicant's arguments filed 08-3-06 have been fully considered but they are not persuasive.

The applicant argues that the newly amend claims should overcome prior art rejection (Pages 15-16).

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Upon further consideration of the newly amended claim limitations for Claim 1, Bejan still meets the claim limitations. The applicant amended the claim limitation to include "producing one or more sets of variation scenes that introduce content that reflects the consequences of previous decisions selected from among the alternative decisions presents prior to the linking scene" which is met by Bejan as disclosed: "intersection scenes brings all the various branches together in time and the branching then continues (Column 10, lines 1-21).

Claims 4, 7, 9, 23, 24, 30 have been amended to add a similar limitation to Claim 1. See above for response.

4. In regards to Claim 32, no substantial amendments were made to the claims and therefore the rejection is maintained. The applicant did not provide arguments for the claim.

In regards to Claims 18, 27, 31, and 34, which are similar to Claim 32, have been amended to add a claim limitation similar to "presenting to the viewer the alternative content in the act that is appropriate for the order in which the act is viewed". Arguments were not made other than that the new amendments overcome the prior art. Shields discloses presenting to the viewer the alternative content in the act that is appropriate for the order in which the act is viewed (Column 6, lines 1-57). The rejection is maintained.

5. Applicant's arguments with respect to claims 18, 27-29 and 31 have been considered but are moot in view of the new ground(s) of rejection (Bejan).

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 9-18, 20-31, 34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claim 9 (and dependent claims) recites “an interactive entertainment embodied in a digital video storage and having an overall storyline to be delivered to a viewer” which does not impart functionality to a computer or computing device, and is thus considered nonfunctional descriptive material.

Claims 18 (and dependent claims), and 34 recite “an interactive entertainment embodied in a digital video storage medium and having an overall storyline to be delivered to a viewer” which does not impart functionality to a computer or computing device, and is thus considered nonfunctional descriptive material.

Claim 23 recites, “an interactive entertainment embodied in digital text, or digital text and images, on a storage medium and having an overall storyline to be delivered to a viewer” which does not impart functionality to a computer or computing device, and is thus considered nonfunctional descriptive material.

Claims 24, 27 and dependent claims recite “an interactive entertainment embodied in an electronic format and having an overall storyline to be transmitted to a viewer over a communications network” which does not impart

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functionality to a computer or computing device, and is thus considered nonfunctional descriptive material.

Claims 30-31 recite "an interactive entertainment embodied in an electronic format and having an overall storyline to be transmitted to a viewer over a broadcast network" which does not impart functionality to a computer or computing device, and is thus considered nonfunctional descriptive material.

Such nonfunctional descriptive material, in the absence of a functional interrelationship with a computer, does not constitute a statutory process, machine, manufacture or composition of matter and is thus non-statutory per se.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1-4, 6-10, 18, 20-22, 24, 27, 30, 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Bejan et al (US 5,465,384 and hereafter referred to as "Bejan").

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Regarding Claims 1, Bejan discloses a method for structuring scene sequences for interactive entertainment (Figure 3), the method comprising the steps of:

(a) providing a plurality of potentially viewable scenes to deliver an overall storyline to a viewer (Column 9, lines 39-67, Column 10, lines 1-25);

(b) delivering some of the scenes to the viewer as branching points at which alternative decisions are presented that will determine the next scene sequence or subsequent act to be presented to the viewer (Column 8, lines 40-50, Column 9, lines 39-67, Column 10, lines 1-25);

(c) for each alternative decision at a branching point, having available to present to the viewer a scene sequence corresponding to the decision (Column 9, lines 55-66);

(d) enabling the viewer to select one of the alternative decisions; (Column 8, lines 3-6);

(e) in response to the viewer's selected one of the alternative decisions, presenting the scene sequence that corresponds to the decision (Column 8, lines 47-50);

(f) structuring the branching points and their related scene sequences such that essentially every set of scene sequences determined by viewer decisions eventually reaches at least one linking scene containing content that is not dependant upon the particular decisions made prior to the linking scene (Column 10, lines 5-12);

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(g) producing one or more sets of variation scenes that introduce content that reflects the consequences of previous decisions selected from among the alternative decisions presented prior to the linking scene, each set of variation scenes being associated with a scene that is viewable after the linking scene or after intersection scene or linking scene branching continues (Column 8, lines 40-50, Column 9, lines 39-67, Column 10, lines 1-25); and

(h) when the viewer is brought to a scene sequence that contains a set of variation scenes, interspersing into the scene sequence the variation scene corresponding to the viewer's selected one of the alternative decisions from among the alternative decisions presented prior to the linking scene (Column 9, lines 39-67, Column 10, lines 1-25).

Regarding Claims 4, 7 and 18, Bejan discloses a method for structuring scene sequences for interactive entertainment (Figure 3), the method comprising the steps of

(a) providing a plurality of potentially viewable scenes to deliver an overall storyline to a viewer in a plurality of acts, each act containing potentially viewable scenes (Figure 3, 2<sup>nd</sup> Branch A, 2<sup>nd</sup> Branch B, 3<sup>rd</sup> Branch C);

(b) in at least one of the acts, presenting to the viewer alternative decisions that will determine an order in which at a subsequent act will be presented from which the viewer selects one of the alternative decisions (Figure 3);



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(c) enabling the viewer to select one of the alternative decisions (Column 8, lines 3-6);

(d) and in each act that can be presented in a different order, providing neutral scenes in which the content is not dependent upon the order in which the act is viewed, and providing sets of alternative scenes in which the content is dependent upon the order in which the act is viewed (Column 10, lines 5-12); and providing alternative connecting scenes leading into and out of the act (Figure 3, Column 9, lines 39-67, Column 10, lines 1-22);

(e) and prompting the viewer to make one of the alternative decisions that will determine the order of a subsequent act (Figure 3);

(f) presenting to the viewer, in the act determined by his decision, neutral scenes of the act interspersed with alternative scenes that reflect the consequences of previous decisions selected from among the alternative decisions presented prior to the linking scene that correspond to the viewer's selected one of the alternative decisions (Column 9, lines 39-67, Column 10, lines 1-25).

Regarding Claims 9, 24 and 30, Bejan discloses an interactive entertainment embodied in a videodisk player and having an overall storyline to be delivered to a viewer (Figure 1, 36, Figure 3), an interactive entertainment embodied in electronic format and having an overall storyline to be transmitted to a viewer (Figure 1, 36, Figure 3), said interactive entertainment comprising: (a) a plurality of potentially viewable scenes (Figure 3, Column 9, lines 39-67, Column 10, lines 1-22); (b) some of the scenes defining branching points of the

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entertainment by presenting alternative decisions from which the viewer selects on of the alternative decisions (Figure 3, Column 9, lines 39-67, Column 10, lines 1-22); (c) for each alternative decision at a branching point, a sequence of scenes corresponding to the decision (Figure 3, Column 9, lines 39-67, Column 10, lines 1-22); (d) the branching points and their related scene sequences being structured such that essentially every set of scene sequences determined by viewer decisions eventually reaches at least one linking scene containing content that is not dependant upon the particular decisions made prior to the linking scene (Column 10, lines 1-22; and (e) one or more sets of variation scenes that introduce content that reflects the consequences of previous decisions selected from among the alternative decisions presented prior to the linking scene and that corresponds to the viewer's selected one of the alternative decision, each set of variation scenes being associated with a scene that is viewable after the linking scene (Figure 3, Column 9, lines 39-67, Column 10, lines 1-22).

Regarding Claims 27 and 31, Bejan discloses an interactive entertainment embodied in a videodisk player and electronic format and having an overall storyline to be delivered to a viewer (Figure 1, 36, Figure 3), an interactive entertainment embodied in electronic format and having an overall storyline to be delivered to a viewer (Figure 1, 36, Figure 3), said interactive entertainment comprising: (a) a plurality of potentially viewable scenes grouped as a plurality of acts or branches (Figure 3, Column 9, lines 39-67, Column 10, lines 1-22); (b) sat least one of the acts having a scene that presents at least one set of alternative decisions from which the viewer selects on of the alternative decisions

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(Figure 3, Column 9, lines 39-67, Column 10, lines 1-22); (c) each act that can be presented in a different order having neutral scenes in which the content is not dependant upon the relative order in which the act is viewed, and sets of alternative scenes in which the content is dependant upon the relative order in which the act is viewed (Figure 3, Column 9, lines 39-67, Column 10, lines 1-22); (d) present to the viewer the alternative content in the act that is appropriate for the order in which the act is viewed (Column 8, lines 40-50, Column 9, lines 39-67, Column 10, lines 1-22).

Regarding Claim 2, Bejan discloses all the limitations of Claim 1. Bejan discloses producing the variation scenes in a set with essentially the same characters and props, such that the variation scenes in a set differ from each other by the dialog and expression of at least one character or a scene is displayed to the audience and the audience is presented with three choices on the direction of the plot and can select a character (Column 8, lines 40-50, Column 9, lines 39-45).

Regarding Claims 3, 6 and 8, Bejan discloses all the limitations of Claims 1, 4 and 7 respectively. Bejan discloses the entertainment may be viewed simultaneously by more than one interactive viewer, further comprising the steps of: (a) delivering some of the scenes to each interactive viewer as branching points at which alternative decisions are presented that will determine the next scene sequence to be presented (Column 8, lines 40-50, Column 9, lines 39-45); and (b) enabling different interactive viewers to make at least one of the alternative decisions (Column 8, lines 3-6).

Regarding Claims 10, 20, and 22 Bejan discloses all the limitations of Claims 9, 18, and 21 respectively. Bejan discloses a digital video player (Figure 1, 34) having means for enabling the viewer to make the alternative decisions, and (Column 8, lines 3-6) (b) software for presenting the scene sequences that corresponds to the viewer's decisions, for identifying when the viewer is brought to a scene sequence that contains a set of variation scenes, and for interspersing into that scene sequence the variation scene from the set that is related to the particular decision made or in order to control the videodisk player based on the polling computer and main computer must have software and data concerning the images stored in the video disk. Bejan discloses a suitable software system, which allows the main computer to store information concerning the time code or other address of images stored on the videodisk (Column 6, lines 50-61).

Regarding Claim 21, Bejan discloses all the limitations of Claim 18. Bejan discloses that the selectable-order acts have alternative connecting scenes leading into and out of the act including leading in scenes 2<sup>nd</sup> Branch A, B, C and leading out to 3<sup>rd</sup> A, B, C (Figure 3).

10. Claims 18, 20-22, 27-29, 31-34 is rejected under 35 U.S.C. 102(b) as being anticipated by Shiels et al (US 5,754,770 and hereafter referred to as "Shiels").

Regarding Claims 18, 27, 31, 32 and 34, Shiels discloses an interactive entertainment embodied in a local storage having an overall storyline to be delivered to a viewer (Figure 3, Figure 6), an interactive entertainment embodied

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in an electronic format having an overall storyline (Figure 3, Figure 6), an interactive entertainment embodied in an electronic format having an overall storyline (Figure 3, Figure 6), a method for providing interactive entertainment in periodic serial format (Abstract, Column 6, lines 34-44), and an interactive entertainment embodied in a storage and having an overall storyline (Column 3, lines 43-45), the method comprising the steps of and the interactive entertainment: (a) providing a plurality of potentially viewable scenes to deliver an overall storyline to a viewer in a plurality of periodic episodes (Figure 6, B, D), each episode containing potentially viewable scenes; (b) in at least one of the episodes, presenting to the viewer alternative decisions that will determine an order in which a subsequent episode will be presented (Column 6, lines 34-44); (c) enabling the viewer to select one of the alternative decisions (Column 6, lines 29-29); (d) in each episode that can be presented in a different order, providing alternative connecting scenes leading into and out of the episode or having scenes A leading into the episodes and C, H, E, lead out of the episodes (Figure 6, B, D, A); (e) prompting the viewer to select one of the alternative decisions that will determine the order of a subsequent episode (Column 6, lines 34-44); (f) presenting to the viewer, in the subsequent episode determined by his decision, the alternative connecting scenes that are appropriate to the order in which the episode is presented (Column 6, lines 3-66).

Regarding Claim 21, Shiels discloses all the limitations of Claim 18.

Shiels discloses the selectable-order acts have alternative connecting scenes

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leading into and out of the act or B and D have A leading in and scenes F, E, H, and C leading out (Figure 6).

Regarding Claims 20 and 22, Shiels discloses limitations of Claims 18 and 22. Shiels discloses a digital video player, comprising; (a) means for enabling the viewer to make the alternative decisions that determine the order of the selectable-order acts (Column 6, lines 25-30, Figure 1, Figure 5) and (b) the CPU controls the operations of the set top box by receiving program information specify how the processor is to handle audio and video stream (Column 4, lines 1-67, Column 5, lines 1-8) which necessarily includes software for presenting to the viewer, in the acts determined by his decision, the connecting scenes appropriate to the order in which the act is presented.

Regarding Claim 28, Shiels discloses all the limitations of Claim 27. Shiels discloses the interactive entertainment is transmitted to a viewer over a communications network in real time or the VOD server transmits data over a communications network to STB when then displays data on TV (Column 3, lines 59-67).

Regarding Claim 29, Shiels discloses all the limitations of Claim 27. Shiels discloses the interactive entertainment is transmitted to a viewer over a communications network (Column 3, lines 50-53) and stored on a storage device (Column 4, lines 1-55).

Regarding Claim 33, Shiels discloses all the limitations of Claim 32. Shiels discloses the entertainment may be viewed simultaneously by more than one interactive viewer, further comprising the steps of; (a) presenting to each

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interactive viewer alternative decisions that will determine an order in which a different subsequent episode will be presented or the user will be shown a menu of options on the screen of the television with the menu displaying the alternative decision that the user may make for the narrative (Column 6, lines 34-44); and (b) enabling each interactive viewer to make at least one of the alternative decisions or a user may make at least one alternative decision by using UID (Column 6, lines 25-29).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 11, 13, 14, 16, 17, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bejan in view of Shiels.

Regarding Claim 11, Bejan discloses all the limitations of Claim 10. Bejan is silent on digital video player is a general-purpose computer and monitor. Shiels discloses the digital video player can be in the form of a personal computer (Column 10, lines 27-39). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Bejan to use a general purpose computer and monitor as the digital video player (Column

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10, lines 27-39) as taught by Shiels for the benefit of using a well known device that is owned by many viewers and reduces overall costs.

Regarding Claim 13, Bejan discloses all the limitations of Claim 10. Bejan is silent on digital video player is a set top box (STB) and a television. Shiels discloses the use of a STB, which connected to a television (Column 3, lines 27-42). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Bejan to use a STB, which connected to a television (Column 3, lines 27-42) as taught by Shiels for the benefit of using a well known device that is owned by many viewers and reduces overall costs.

Regarding Claim 14, Bejan discloses all the limitations of Claim 10. Bejan is silent on digital video player is a personal video recorder (PVR) having digital storage capability and a television. Shiels discloses the use of local storage, which many comprise a CD player or digital video player connected to a television via a STB (Column 3, lines 43-50). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Bejan to use a PVR with digital storage capacity and a television (Column 3, lines 43-50) as taught by Shiels for the benefit of using a well known device that is owned by many viewers and reduces overall costs.

Regarding Claim 16, Bejan discloses all the limitations of Claim 10. Bejan is silent on the digital video player is a television having computing capability, wherein the television is adapted to present digital video to a user. Shiels discloses the digital video player is a television having computing capability, wherein the television is adapted to present digital video to a user or that



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necessary computing can be stored in a television (Column 10, lines 27-39).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Bejan to use a television as a digital video player to present digital video to a user (Column 10, lines 27-39) as taught by Shiels for the benefit of using a well known device that is owned by many viewers and reduces overall costs.

Regarding Claim 17, Bejan discloses all the limitations of Claim 10. Bejan is silent on the digital video player is a cable television system having a computer located at its head-end and a television. Shiels discloses the digital video player is a cable television system having a computer located at its head-end and a television (Column 3, lines 43-55). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Bejan to include the digital video player is a cable television system having a computer located at its head-end and a television (Column 3, lines 43-55) as taught by Shiels for the benefit of using a well known device that is owned by many viewers and reduces overall costs.

Regarding Claim 25, Bejan discloses all the limitations of Claim 24. Bejan is silent on the interactive entertainment is transmitted to a viewer over a communications network in real time. Shiels discloses the interactive entertainment is transmitted to a viewer over a communications network in real time or the VOD server transmits data over a communications network to STB when then displays data on TV (Column 3, lines 59-67). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to

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modify Bejan to include the interactive entertainment is transmitted to a viewer over a communications network in real time (Column 3, lines 59-67) as taught by Shiels for the benefit of allowing the viewer to make requests for interactive programming in their own time.

Regarding Claim 26, Bejan discloses all the limitations of Claim 24. Bejan is silent on the interactive entertainment is transmitted to a viewer over a communications network and stored on a storage device. Shiels discloses the interactive entertainment is transmitted to a viewer over a communications network (Column 3, lines 50-53) and stored on a storage device (Column 4, lines 1-55). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Bejan to include the interactive entertainment is transmitted to a viewer over a communications network (Column 3, lines 50-53) and stored on a storage device (Column 4, lines 1-55) as taught by Shiels for the benefit of storing a plurality of branch scenes that may or may not be used.

13. Claims 12, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bejan in view of Abecassis (US 6,553,178).

Regarding Claim 12, Bejan discloses all the limitations of Claim 10. Bejan is silent on the digital video player is a game player and television. In analogous art, Abecassis discloses the digital video play (Figure 5, 500) is a game player and a television (Column 19, lines 52-65), which is connected to a TV (Figure 9, 951, 931-936). Therefore, it would have been obvious to one ordinary skill in the

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art at the time the invention was made to modify Bejan to include the digital video player is a game player and television (Column 19, lines 52-65, Figure 5, 500, Figure 9, 931-936, 951) as taught by Abecassis for the benefit of using a well known device that is owned by many viewers and reduces overall costs.

Regarding Claim 15, Bejan discloses all the limitations of Claim 10. Bejan is silent on the digital video player the digital video player is a computer and a television. Abecassis discloses the digital video player is a computer and a television (column 18, lines 42-45, Column 19, 66-67; Column 21, lines 36-39, Figure 9, 931-936, 951). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Bejan to include the digital video player is a computer and a television (column 18, lines 42-45, Column 19, 66-67; Column 21, lines 36-39, Figure 9, 931-936, 951) as taught by Abecassis for the benefit of using a well known device that is owned by many viewers and reduces overall costs.

14. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of Hendricks (US 6,557,173) and Bejan.

Regarding Claim 23, the applicant's own admitted prior art disclose well-known book-based adventures that allow users to assume the role of a character and make choices within the context of an adventure. These books presented to a reader with short text sequences that conclude with a choice. Based on this choice, the reader is directed to another page in the book where the consequence of the choice is described. However, applicant fails to disclose the

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use of electronic books that are "choose your adventure based" or any of the other limitations of the claim. Hendricks discloses an interactive entertainment embodied in digital text, or digital text and images, on a storage medium and having an overall storyline to be delivered to a viewer (Abstract, Column 20, lines 38-47). In analogous art, Bejan discloses that interactive entertainment comprising: (a) a plurality of potentially viewable pages or scenes (Column 9, lines 39-67, Column 10, lines 1-25); (b) some of the pages defining branching points of the entertainment by presenting alternative decisions which must be made by the viewer (Column 8, lines 40-50, Figure 3); (c) for each alternative decision at a branching point, a sequence of pages corresponding to the decision (Figure 3, 2<sup>nd</sup> Branch A, B, C); (d) the branching points and their related page sequences being structured such that essentially every set of page sequences determined by viewer decisions eventually reaches at least one linking page containing content that is not dependant upon the particular decisions made prior to the linking scene (Column 10, lines 5-22); and (e), one or more sets of variation pages that introduce content that reflect the consequences of previous decisions selected from among the alternative decisions presented prior to the linking page and that correspond to the viewer's selected one of the alternative decisions, each set of variation pages being associated with a page that is viewable after the linking page (Figure 3, Column 9, lines 39-67, Column 10, lines 1-22), means for enabling the viewer to select one the alternative decisions (Figure 5 and Figure 6); and software for selecting one or more variation pages from the set when the viewer is brought to the associated page and for

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interspersing the selected pages adjacent the associated page to introduce content that reflects the consequences of previous decisions (Figure 3, Column 9, lines 39-67, Column 10, lines 1-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the applicant's disclosure with the teachings of Hendricks in order to provide an electronic book that can receive text and images from a cable system headend for benefit of providing users with a create your own adventure electronic book. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the applicant's disclosure with the teachings of Bejan in order to facilitate providing a user with a plurality of viewable pages with some of pages defining branching points of the entertainment for the benefit of providing the users with the ability to determine the plot of the interactive story (Column 1, lines 13-45) as disclosed by Bejan.

### ***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/003,187 in view of Abecassis.

The instant application's "a method for structuring scene sequences for interactive entertainment" is met by "a method of presenting an interactive digital video work that can customize the content presented after branching points to a particular viewer based upon viewer's preferences" of Application No. 10/003,187, as interactive entertainment is based on viewer's preferences.

The instant application's "providing a plurality of potentially viewable scenes to deliver an overall storyline to a viewer; delivering some of the scenes to the viewer as branching points at which alternative decisions are presented that will determine the next scene sequence to be presented to the viewer; for each alternative decision at a branching point, having available to present to the viewer a scene sequence corresponding to the decision; enabling the viewer to select one of the alternative decisions; in response to the viewer's selected one of the alternative decisions, presenting the scene sequence that corresponds to the decision" is met by the limitations "providing a plurality of potentially viewable

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scenes to deliver information content to a viewer; delivering some of the scenes to the viewer as the branching points at which alternative decisions are presented that will determine the next scene sequence to be presented to the viewer; for each alternative decision at a branching point, having available to present to the viewer a scene sequence corresponding to the alternative decision; enabling the viewer to select one of the alternative decisions; in response to the viewer's selected one of the alternative decisions, presenting the scene sequence that corresponds to the decision" of Application No. 10/003187.

The instant application is missing "tracking the viewer's cumulative selected decisions and imputing that particular viewer's preferences and interests based on the viewer's selected decision; producing one or more sets of variation scenes that introduce the information content that address the different possible viewer preferences and interest, based on previous decisions selected from among the alternative decisions presented prior to the scene sequence, each set of variation scenes being associated with a scene that is viewable after the branching points; when the viewer is brought to a scene sequence that contains one of the sets of variation scenes, interspersing into the scene sequence the variation scene corresponding to the viewer's imputed preferences and interests, based on the viewer's selected one of the alternative decisions from among the alternative decisions presented prior to the scene sequence. Abecassis discloses the missing features (Figures 4A, 4B, 4E). It would be obvious to modify the instant application to include the limitation found in Application 10/003,187 as it is taught by prior art.

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The instant application's "structuring the branching points and their related scene sequences such that essentially every set of scene sequences determined by viewer decisions eventually reaches at least one linking scene containing content that is not dependant upon the particular decisions made prior to the linking scene; producing one or more sets of variation scenes that introduce content that reflects the consequences of previous decisions selected from among the alternative decisions presented prior to the linking scene, each set of variation scenes being associated with a scene that is viewable after the linking scene or after intersection scene or linking scene branching continues; and when the viewer is brought to a scene sequence that contains a set of variation scenes, interspersing into the scene sequence the variation scene corresponding to the viewer's selected one of the alternative decisions from among the alternative decisions presented prior to the linking scene" are additional features. It would have been obvious to modify Application No. 10/003,187 to include these limitations as prior art discloses the limitations. Bejan teaches the additional features (Figure 3).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***



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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farzana E. Hossain whose telephone number is 571-272-5943. The examiner can normally be reached on Monday to Friday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FEH  
October 25, 2006

  
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